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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/172,830 10/15/98 ZANCO

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EXAMINER

QM12/0112

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KAVANAUGH, J	
ART UNIT	PAPER NUMBER

3728

DATE MAILED:

01/12/01

AIR MAIL

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/172,830**

Applicant(s)  
**Zanco**

Examiner  
**Ted Kavanaugh**

Group Art Unit  
**3728**



☒ Responsive to communication(s) filed on 7/5/00

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-5 and 7-11 is/are pending in the application.

Of the above, claim(s) 7, 10, and 11 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-5, 8, and 9 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 7

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## DETAILED ACTION

### *Election/Restriction*

1. Claims 7,10,11 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being drawn to a non-elected species. Election was made **without** traverse in Paper No. 5.

### *Claim Rejections - 35 USC § 112*

2. Claims 1-5,8,9 is/are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the phrases “wherein the boot is in substantial part flexible” and “and in substantial part rigid” is unclear and indefinite. More specifically the phrase “in substantial part” is not understood.

In the first office action the examiner found the phrase, in claim 1, “the rigid part of the sole is designed so as to form an interface between the leg and a binding of a ski or in-line roller skate” is vague, unclear and indefinite. Subsequently, applicant changed the phrase to “the rigid part of the sole [is designed so as to form] comprises an interface between the boot and a binding of a ski or in-line roller skate”. This phrase is still unclear and indefinite. It is not clear what element the “interface” is referring to. Applicant’s remarks, other than a couple general

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statements, didn't address this. A review of the specification reveals that perhaps it is the rigid part of the sole that forms the interface between the leg and the binding of a ski or in-line roller skate, see page 3, lines 26-29. Therefore the examiner will treat the claim as if it is the "rigid part" of the sole that is the interface. However, the claim now states the interface is "between the boot and a binding" which is not accurate since the interface is "between the leg and a binding" as stated in the specification.

In claim 2, the phrase "wherein the rigid part (1) of the sole interfaces between the boot and a ski binding having automatic release". This language is similarly indefinite. Moreover, the "automatic release" is not understood. It is not clear what structure such language would encompass.

Throughout the claims applicant refers to the bearing surface (6,7) in several different ways, such as "as at least one cutout", "a profiled part" and "binding means" which leads to confusion. Applicant must use consistent terminology throughout the claims.

In claim 8, the phrase "is a profiled part of standard length" is unclear, inaccurate and indefinite. It is not clear what profile applicant is referring to and the term standard is vague and indefinite. The applicant has amended the specification to clarify that the profile is the bearing surface / cut out (7). However this appears to be inaccurate since it is not the profiled part (6 and 7) that has a standard length but is the length of the rigid part 1, see page 7, lines 4-8

In claims 4 and 5, the "rigid part (5) of the upper" now lack proper antecedent basis. There was previously antecedent basis in claim 3 but that language has now been changed.

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Claim 5 is inaccurate since the cutout (7) is actually provided in the sole (1) and not in the rigid part (5), at least with regard to the elected embodiment.

In claim 3, "the heel" lacks proper antecedent basis and is therefore indefinite.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

4. Claims 1,2,8,9 is/are rejected under 35 U.S.C. 102(e) as being anticipated by 4674202 (*Bourque*).

Bourque teaches a boot having structure substantially as claimed including the sole have a rigid part (the first half of the sole is rigid because of element 10 which is rigid in areas 14 and 16) and the rest of the sole is flexible. The front half of the rigid part (10) has grooves (28) that permit the front half of the sole to be flexible. The rigid part of the sole serves as the interface. The sole of Bourque has a profiled part (the cutout as shown in the rear of sole in figure 2). The cutout will inherently function as binding means. Note the "binding means" in claim 9 is not invoking 112, 6th paragraph.

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5. Claims 1-4 is/are rejected under 35 U.S.C. 102(e) as being anticipated by *US 4246708 (Gladek)*.

Gladek teaches a boot having structure substantially as claimed including the sole have a rigid part in the rear region that encloses the heel and the rest of the sole being flexible. The front half of the sole is flexible due to the apertures (10) that permit the front half of the sole to flex. The rigid sole part serves as the interface.

6. Claims 1-4 is/are rejected under 35 U.S.C. 102(e) as being anticipated by *US 5884420 (Donnadieu)*.

Donnadieu teaches a boot having structure substantially as claimed including the sole have a rigid part (3) in the rear region that encloses the heel and the rest of the sole (15) being flexible. All of the functional claim language and statements of intended use do not make an otherwise unpatentable claim patentable. It is believed to be well settled that "recitation with respect to manner in which claimed apparatus is intended to be employed does not differentiate claimed apparatus from prior art apparatus satisfying structural limitations of that claimed" Ex parte Masham 2 USPQ2nd 1647. Also see Ex parte Casey 152 USPQ 235. The law of anticipation does not require that an anticipatory reference teach what the applicant is claiming or has disclosed, but only that the claims "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference. See Kalman v. Kimberly Clark Corp., 713 F.2d 760, 218 USPQ 871 (Fed Cir. 1983). Furthermore, it is only necessary that the reference include structure capable of performing the recited function in order to meet the functional limitations of a

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claim. See In re Mott, 557 F.2d 266, 194 USPQ 305 (CCPA 1977). Since the reference device has all of the same structural elements, as noted above, it would clearly seem to be inherently capable of performing the functions as claimed. The rigid sole part serves as the interface.

7. Claims 1-4 is/are rejected under 35 U.S.C. 102(e) as being anticipated by *US 5899006 (Donnadieu)*.

Donnadieu teaches a boot having structure substantially as claimed including the sole have a rigid part (3,8) in the rear region that encloses the heel and the rest of the sole (2) being flexible. All of the functional claim language and statements of intended use do not make an otherwise unpatentable claim patentable. It is believed to be well settled that "recitation with respect to manner in which claimed apparatus is intended to be employed does not differentiate claimed apparatus from prior art apparatus satisfying structural limitations of that claimed" Ex parte Masham 2 USPQ2nd 1647. Also see Ex parte Casey 152 USPQ 235. The law of anticipation does not require that an anticipatory reference teach what the applicant is claiming or has disclosed, but only that the claims "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference. See Kalman v. Kimberly Clark Corp., 713 F.2d 760, 218 USPQ 871 (Fed Cir. 1983). Furthermore, it is only necessary that the reference include structure capable of performing the recited function in order to meet the functional limitations of a claim. See In re Mott, 557 F.2d 266, 194 USPQ 305 (CCPA 1977). Since the reference device has all of the same structural elements, as noted above, it would clearly seem to be inherently capable of performing the functions as claimed. The rigid sole part serves as the interface.

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***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 5,8,9 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over *either [Donnadieu '006 or '420 or Gladek] in view of Bourque '202 and US 4186500 (Salzman)*.

Donnadieu and Gladek all teach a boot (cross-country boots) substantially as claimed except for a cutout/profile part/binding means. Bourque and Salzman both teach cross-country boots have a rear cutout portion (or a profile part or binding means). It would have been obvious to provide the boot of either Donnadieu or Gladek with a cutout portion, as taught by Bourque and Salzman, to provide reinforcement to the sole of the boot and to facilitate securing to a binding.

10. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bourque '202 in view of Donnadieu or Gladek.

Bourque teaches a boot substantially as claimed (see the rejection above for details) except for a rear part rigidly enclosing the heel. Donnadieu and Gladek both teach providing a boot with the sole having an integral rigid heel part. It would have been obvious to one of ordinary skill in the art to provide the boot as taught by Bourque with the sole having a rigid part



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enclosing the heel, as taught by either Donnadieu or Gladek, to prevent twisting in the rear part of the boot.

*Response to Arguments*

11. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

*Conclusion*

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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13. Telephone inquiries regarding the **status of applications or other general questions**, by persons entitled to the information, "should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

In order to reduce pendency and avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (703) 305-3579 or (703) 305-3580 (**FORMAL FAXES ONLY**). This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify Examiner Ted Kavanaugh of Art Unit 3728 at the top of your cover sheet.

Inquiries concerning the merits of the examination should be directed to Mr. Kavanaugh whose telephone number is (703) 308-1244.

  
Ted Kavanaugh  
Primary Examiner  
Art Unit 3728

TK  
January 10, 2001